

Short Course in Reissue Practice

- Should You Examine This Reissue Application?

If the original patent has expired for failing to pay maintenance fees or because its term has run, we cannot reissue the patent, and so we do not examine the reissue application.

All claims in a reissue application, including any claims that are original patent claims, are examined precisely as you would examine the claims in a regular utility application. But see below regarding restriction.

- Reissue Oath or Declaration

The oath or declaration in a reissue case must include all of the components that an oath or declaration in a regular patent application contains. So right off the bat, **a reissue case should be treated as you would treat any patent application; make sure that the oath or declaration complies with 37 CFR 1.63.**

In addition, **the originally filed reissue oath or declaration must specify at least one error that the reissue application is being filed to correct.** See 37 CFR 1.175(a), and MPEP 1444 for a general discussion. MPEP 1414 contains a detailed explanation of all of the required parts of a reissue declaration, including a discussion of what errors can be corrected by reissue (not every error can be corrected by reissue).

The originally filed reissue oath or declaration must state that *all* errors being corrected by reissue arose without deceptive intent. Remember, only one such error needs to be expressly stated, but more than one error can be corrected in the same reissue application, and usually is. **ALL errors must have arisen without deceptive intent.**

- Ownership and Surrender of the Original Patent

Often, the patent for which reissue application is filed has been assigned. That means that someone other than the inventor owns the patent. The owner of the patent must assent to having the patent "changed" by reissue, and agree to surrender the original patent in exchange for a reissue patent. **The examiner should make sure that the assent (consent) of the assignee and an offer to surrender the original patent (or the original patent itself) are in the application file. If not, they must be required in the next action.**

When someone who purports to be an assignee "takes action" in a patent application, the Director must know that this someone really is an assignee. Filing a reissue application is "taking action" in a patent application. **Therefore, the reissue application must include a certificate under 37 CFR 3.73(b) establishing the assignee's authority to file (and prosecute) the application.** (MPEP 324 explains 37 CFR 3.73(b) in detail.) **If there is no 37 CFR 3.73(b), one must be required.**

A reissue application cannot be allowed by the examiner unless the original patent has been surrendered and is in the reissue application file, or an oath or declaration attesting that the original patent has been lost is filed. **If you don't have either the original patent or the**

verified statement that the original patent is lost in the file, you may Quayle the case, but cannot allow it.

- Restriction

Restriction can never be required in a reissue application. There is case law dealing with claims to an invention which was not claimed in the original patent; most often they are permitted but sometimes they are not. See MPEP 1450, and/or consult a SPRE.

- Amendments in a Reissue Application

Amendments in reissue applications must follow specific formats created by 37 CFR 1.121(b). See MPEP 1453. **If you see an amendment to the specification or claims that directs that words be inserted, and/or that words be canceled, consult a SPRE. If you see a claim that is new to the patent (has been added in reissue application) and is not entirely underlined, consult a SPRE.** When a new claim is later amended, all of that claim should be underlined, and no words should appear in brackets, because **all changes are relative to the text of the original patent. When in doubt, consult a SPRE.**

- Recapture

Recapture can be summed up this way: **in general, if an applicant added a limitation in order to secure allowance of the claims in the original patent application, (or if a limitation was argued as being the limitation that conveyed patentability to a claim that was rejected and not amended), then that limitation cannot be removed by reissue.** See MPEP 1412.01. Consult a SPRE if you think that recapture may be involved.

You cannot determine whether there is a recapture problem, and for that matter cannot really examine the reissue case in terms of the alleged errors, if you don't have the patented file when you examine the reissue. You should order the patented file prior to first action, and retain it throughout prosecution of the reissue application.

- Supplemental Reissue Oath or Declaration

If you are not allowing the reissue application on the first action, the chances are that any amendment changing the claims has technically had the effect of introducing the correction of an error that was not one of the errors being corrected when the reissue application was filed. **Therefore, prior to allowance of an amended reissue application, consider whether a supplemental oath or declaration stating the "for any error being corrected which was not covered by the original declaration, every such error arose without deceptive intent must be filed.** See 37 CFR 1.175(b). and MPEP 1444.

Sometimes, the specifically stated error in original oath or declaration is no longer being corrected by the reissue application. For example, let's say that the error was that the original claims were too narrow. You found some dynamite prior art for the first action, and actually rejected the original patent claims as well as the newly added broader claims. Applicant has now amended the original patent claims to make them narrower and avoid your rejection. The original error (too narrow) has now vanished, and been replaced by a new error (too broad). **When the specific error stated in the original oath or declaration is no longer in**

the reissue application, a supplemental declaration as above is required, and must also include a statement specifically identifying at least one error being corrected by reissue. See MPEP 1414.01.

- Claim Numbering

When allowing a reissue application, the original patent claims are never renumbered, even if one or more of them is canceled. Renumber only those claims which are added by the reissue, and begin with the number next higher than the last patent claim.